REMARKS

Pursuant to the Office Action dated February 20, 2004, independent claims 1, 10, 17 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goodman in view of Franz and Nakajima. In the Office Action, the Examiner concedes that Goodman fails to teach the adjustment of a cursor to minimize inadvertent interruption of user input. Franz does not cure the deficiency of Goodman.

As was explained in the Appeal Brief received in the Patent Office on February 9, 2004, Franz does not address cursor control for avoiding inadvertent interruption of user input. That is, the passages cited in the Office Action address the following: (1) freezing cursor motion for a predetermined period of time in response to a pointing event to minimize the effects of inadvertent cursor movement during the pointing event; (2) changing cursor speed without significant interruption of the user's work; (3) entering a point-lock mode, which requires the user to do more than release a pointing key to exit the pointing mode; and (4) changing the device temporarily to typing mode automatically in response to the user entering typing data. Franz, 13:62-14:4; 18:57-19:9; 19:52-20:5. Thus, the cited passages fail to disclose adjustment of the cursor to avoid inadvertent interruption of user input as called for in amended claim 1. *See also*, paper no. 10, page 11 ("Franz et al. fails to teach the control of said cursor to enable user input without accidental interference from said pointing device.")

It was further argued in the Appeal Brief that a *prima facie* case of obviousness was not established, as there was no specific citation or reference provided to indicate where the prior art teaches or suggests a motivation to modify or combine. This deficiency was not cured in the present Office Action. Thus, for this additional reason a *prima facie* case of obviousness has yet to be established.

In the present Office Action, Nakajima is relied upon as teaching adjustment of a cursor of a pointing device in response to detecting key activation, adjustment of the cursor to minimize inadvertent interruption of user input. Nakajima, 13:37-45 and 21:47-57; *see also*, 13:62-14:4 and 30:3-14. In particular, the Office Action cites the following:

> Moreover, invalidation of the processing in steps S214, S220 and S226 prevents an accidental input to the specific regions on the touch-sensitive tablet easily touchable with a finger and the like during a keyboard entry or other occasions.

21:54-57. When considered in context, it is submitted that this passage fails to disclose adjustment of a cursor of a pointing device in response to detecting key activation, the adjustment of the cursor to avoid inadvertent interruption of user input.

Steps S214, S220 and S226 may be found in Figure 18 of Nakajima. Figure 18 is a flowchart for "processing in the touch-sensitive tablet (Figures 15-17) in response to user's double tapping." 20:8-10 (emphasis added). Specifically, double tapping on or around a given "double tap function region" of the touch-sensitive tablet causes execution of a specific function. 18:31-63. Thus, the paragraph relied on in the Office Action follows an outline of "the processing" shown in Figure 18.

Pursuant to the processing in Figure 18, recognition of a double tap in a double tap function region results in the retrieval and execution of the operation corresponding to the desired function. S226; 21:47-53; 18:31-39. However, where a first tap is not within or around a double tap function region processing on normal tapping is performed. S214; 20:45-50. Likewise, if the first tap is within a double tap function region but the second tap is not, then the normal processing on the present tapping is performed. S220; 21:4-17. In other words, if double tapping is not recognized in a double tap function region then the cursor is moved normally or single tap processing is executed. 18:51-56. Thus, it is respectfully submitted that "invalidation of the processing in steps S214, S220 and S226" refers to the normal cursor movement/single tap processing, or retrieval and execution of the desired operation. Each of these outcomes prevents accidental input to the double tap function region. That is, the "double tap" function is executed only where a deliberate double tap is detected in the double tap region, which is not accidental. Where a deliberate double tap is not detected, the cursor is moved normally or single tap processing is executed.

This understanding is supported by a different embodiment of Nakajima where a function is not executed when the user's first touch in a continuous touch motion is not at a particular location. For example, input operation M1 is not recognized until a user's finger that is touching the AtL function region is moved in the right direction to reach a horizontal movement detecting region. 28:1-4; Figures 26-27. In contrast, where the starting point of a touch is not within the AtL function region, the function assigned to this region is not executed and the input operation is processed as an instruction for a normal cursor moving operation. 30:3-14. Again, Nakajima

teaches normal processing to prevent misoperation of a special function region on a touch sensor. *Id.*

Further, referring back to Figure 18, the double tapping system may be terminated at S204, which "cancels" steps S214, S220 and S226. Nevertheless, even where double tapping is terminated at S204, tapping is still detected at S202. 20:12-16. Notably, Figure 18 does not show a different way to "invalidate" steps S214, S220 and S226. Thus, it is submitted that Nakajima fails teach adjustment of the cursor to avoid inadvertent interruption of user input upon detection of key activation. That is, to prevent accidental activation of a special function, Nakajima processes the input as normal cursor movement. Clearly this does not teach what is claimed.

Even if Nakajima is (wrongly) construed as teaching adjusting a cursor of a pointing device to avoid inadvertent interruption of user input, the so-called adjustment is not specifically disclosed as being in response to key activation. That is, if the position is taken that the individual steps S214, S220, and S226 are "invalidated" Nakajima does not address how this "invalidation" occurs. Namely, Figure 18 does not show "invalidation" of these steps. Without a showing of how "invalidation" occurs, it is submitted that Nakajima falls short of disclosing adjustment in response to detecting key activation.

Additionally, there is no citation to the references (the only prior art relied on) for the alleged "motivation or suggestion" to combine or modify. Thus, the conclusion is unsupported by evidence and or is merely hindsight reasoning. Further, Goodman and Franz teach away from the type of pointing device shown in Nakajima. Goodman 1:65-2:8; Franz, 3:32-35. Accordingly, for these additional reasons, a *prima facie* case of obviousness has yet to be established.

Independent claims 15 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Franz in view of Paratore. In the Office Action, the Examiner concedes that Franz fails to teach the control of a cursor to enable user input without accidental interference from the pointing device. Paratore fails to cure the deficiency of Franz.

For example, pursuant to Paratore, to switch from a keyboard input mode to pen input mode, a switch 22a and a bracket 22b are engaged. Figure 3; 4:12-26. That is, when the bracket and switch are engaged the keyboard is disabled. *Id.* Notably, the passages relied on by the Examiner are not directed to cursor control in response to detecting key activation. Rather, they

are directed toward disablement of the keyboard in total, in response to a switch. The pen input mode is never disabled. *See,* Figure 5.

In contrast, according to some embodiments of the present invention, the keys are activated, and in response thereto a cursor of a pointing device is controlled. Thus, Paratore teaches away from claims 15 and 23. Further, complete disablement of a keyboard would render Franz inoperable. That is, Franz's integrated device utilizes a keyboard. Disablement of the keyboard would not be desirable to Franz. Thus, Franz teaches away from combination with Paratore. Furthermore, no evidence in the prior art has been provided to show a motivation, suggestion or desirability to do what the applicant has done. As such, for at least these reasons, a *prima facie* case of obviousness has not been established.

In view of the amendments and remarks above, the application is believed to be in condition for allowance. The Examiner is kindly asked to pass the application to issue.

Respectfully submitted,

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Rhonda L. Sheldon, Reg. No. 50,457
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Suite 100
Houston, TX 77024
713/468-8880 [Phone]
713/468-8883 [Fax]

Customer No.: 21906